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MAILED
MAR 28 2011
OFFICE OF PETITIONS

In re Patent No. :
6,463,803 :
Application No. 09/749,693 : ON PETITION
Filing Date: December 28, 2000 :
Issue Date: October 15, 2002 :
Attorney Docket No. PM 275339 ND-A050- :
US5DIV# :

This is a decision on the petition under 37 CFR 1.182, filed January 28, 2011, requesting withdrawal of a terminal disclaimer filed in the above-cited application and replacement with a corrected terminal disclaimer.

The petition is **dismissed**.

A review of the application file history reveals that a terminal disclaimer was filed on August 20, 2001, in the above-cited application wherein applicants disclaimed the terminal part of any patent granted on this application which would extend beyond the expiration date of United States Patent No. 5,416,916. The terminal disclaimer was accepted and made of record. Patentees now file the instant petition requesting that the terminal disclaimer filed August 20, 2001, be withdrawn because of a typographical error in the application number that was being disclaimed. The terminal disclaimer cited U.S. Patent No. 5,416,916 when it should have cited United States Patent No. 5,461,916. Patentees request that the incorrect terminal disclaimer be withdrawn and that the corrected terminal disclaimer, filed herewith, be made of record.

It is noted that Section 1490(VII) (B) of the Manual of Patent Examining Procedure (MPEP) states, in pertinent part, that:

The mechanisms to correct a patent — Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).

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Where a terminal disclaimer was submitted to overcome a nonstatutory double patenting rejection (made during prosecution of an application which has now issued as a patent), and the numbers for the patent being disclaimed in the terminal disclaimer were inadvertently transposed (e.g., 6,444,316 written as 6,444,136), a petition under 37

CFR 1.182 may be filed to withdraw the terminal disclaimer with the incorrect (transposed) patent number (recorded in the issued patent), and replace it with a corrected terminal disclaimer having the correct patent number. In this instance, the inadvertency is clear from the record. If the transposing error resulted in an earlier patent term expiration date than provided by the corrected terminal disclaimer, a statement must be included in the corrected terminal disclaimer to retain that earlier expiration date. The absence of such a statement will result in the Office declining to exercise its discretion to grant relief.

Based on the above-cited section of the MPEP, it is not appropriate to grant the instant petition because the corrected terminal disclaimer did not contain a statement retaining any earlier expiration date. It is noted that petitioner states:

[a]pplicants also respectfully assert that the earlier patent term period based on the incorrect patent should not be retained since the initial error occurred with the Examiner and not the Applicant. Applicants respectfully assert that the patent term be based on patent 5,461,916.

Excerpt taken from "Petition under 37 CFR 1.182 to Withdraw the Terminal Disclaimer with the Incorrect (Transposed) Patent Number, and Replace it With a Corrected Terminal Disclaimer Having the Correct Patent Number, filed January 28, 2011, pg.4.

A review of the relevant patent histories reveals that U.S. Patent No. 5,416,916, which was cited in the terminal disclaimer filed August 20, 2001, has an earlier expiration date than U.S. Patent No 5,461,916, which is cited in the terminal disclaimer filed January 28, 2011. In such an instance, petitioner is required to make a statement in the "corrected" terminal disclaimer retaining the earlier expiration date. This is true notwithstanding the reason the patent numbers were transposed. The petition must be dismissed because the terminal disclaimer filed January 28, 2011, was not accompanied by a statement retaining the earlier expiration date.

Any renewed petition may directed to the following:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Questions regarding this decision may be directed to the undersigned at (571)272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
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